REMARKS

Claims 1-6 are pending in the present application, after the addition of claim 6. Claims 1-5 have been amended. Applicants respectfully submit that all pending claims are in allowable condition, for at least the following reasons.

Claims 1-4 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, the Examiner indicated that "the body of the claim fails to positively set forth the steps that comprise the method," and that "the body of the claim fails to positively set forth the steps which switch two signals" as indicated in the preamble. In response, the preamble of claim 1 has been amended to recite a method of "controlling an image switching apparatus," and the body of claim 1 has been amended to explicitly recite the method steps of "comparing" the two video signals and "setting the switch." In view of the foregoing amendments to claim 1, Applicants respectfully submit that claim 1 and its dependent claims 2-4 are in compliance with 35 U.S.C. § 112, second paragraph.

Claims 1-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 2,944,108 ("Houghton"). Applicants respectfully submit that claims 1-3 are allowable over Houghton, for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third,

the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Amended claim 1 recites, in relevant parts, a "method of controlling an image switching apparatus, the image switching apparatus having a switch for switching between a video signal supplied by a camera and a video signal supplied by a recording apparatus," which method includes "comparing . . . the video signal coming from the recording apparatus with the video signal supplied by the camera," and "setting the switch into an operating mode selected on the basis of the comparison." In support of the rejection of claims 1-3, the Examiner contends that "claims 1-3 differ from the teachings of Houghton only in that Houghton does not explicitly state that the local source can comprise a camera," and that "one skilled in the art would have recognized that the reference to the 'local source," obviously, encompasses cameras." (Office Action, p. 3). However, Applicants note that Houghton merely discloses synchronizing television video signals "derived from a magnetic tape" and "locally generated" television video signals, (col. 1, l. 18-22), and nothing in Houghton discloses or suggests "**setting the switch** [of an image switching apparatus] **into an operating mode selected on the basis of the comparison**" between the video signal coming from the recording apparatus and the video signal supplied by the camera. In fact, Houghton does not even disclose or suggest a switch which is controlled based on the comparison of the video signals.

For at least the foregoing reasons, claim 1 and its dependent claims 2 and 3 are allowable over Houghton. Withdrawal of the obviousness rejection of claims 1-3 is respectfully requested.

Claim 4 was objected to as being dependent upon a rejected base claim, but the Examiner indicated that claim 4 would be "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." In response, claim 4 has been rewritten in independent form to include the limitations of amended claim 1 (which was amended in response to the rejection based on U.S.C. § 112, second paragraph). Accordingly, Applicants respectfully submit that claim 4 is in allowable condition.

The Examiner has indicated that "Claim 5 avoids the art of record." Applicants have amended claim 5 to delete the reference numerals and change the phrase "characterized in that" to "wherein." Applicants respectfully submit that claim 5 is in allowable condition.

New claim 6 depends from claim 1 and recites that "the selected operating mode is chosen if the video signal supplied by the recording apparatus is different from the video signal supplied by the camera." Applicants respectfully submit that claim 6 is allowable over Houghton by virtue of its dependence on allowable claim 1. In addition, claim 6 is allowable over Houghton because Houghton fails to teach or suggest the feature that "the selected operating mode [of the switch] is chosen if the video signal supplied by the recording apparatus is different from the video signal supplied by the camera."

CONCLUSION

In view of the foregoing, it is respectfully submitted that claims 1-6 are in condition for allowance. A prompt issuance of a Notice of Allowance is respectfully requested.

Respectfully Submitted,

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